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In re Application of:	:	
UNDERBRINK et al.	:	DECISION UNDER 37 CFR
Application No.: 10/570,833	:	1.137(b) and 1.497(d)
PCT Application No: PCT/US2004/028926	:	
Int. Filing Date: 02 September 2004	:	
Priority Date: 02 September 2003	:	
Attorney's Docket No.: SIRF-113US	:	
For: SIGNAL PROCESSING SYSTEM FOR	:	
SATELLITE POSITIONING SIGNALS	:	

This is in response to the "Renewed Petition Under 37 C.F.R. §1.137(b)" and "Renewed Petition Under 37 C.F.R. 1.497(d)" filed 15 December 2009.

BACKGROUND

The present application became abandoned for failure to timely file a proper reply to the "Notification of Defective Response," mailed 29 May 2008, requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b).

In a decision mailed 03 June 2009, applicants' request to correct inventorship under 37 CFR 1.497(d) and petition to revive under 37 CFR 1.137(b) were dismissed. The petition to revive was dismissed for failure to provide the required reply. Specifically, the decision noted that a grantable request under 37 CFR 1.497(d) was not filed in that adequate written consent of the assignee was not provided. In addition, the decision noted that applicants failed to correct the composite declaration defect noted in the 08 November 2007 decision vis-à-vis inventors Underbrink, Falk, Gronemeyer and Protic.

On 05 October 2009, applicants filed a renewed petition under 37 CFR 1.137(b); renewed request under 37 CFR 1.497(d), and complete executed declarations by the inventors.

On 13 November 2009, a decision was mailed dismissing the petition under 37 CFR 1.137 and request under 37 CFR 1.497(d) on the grounds that applicants failed to provide proper written consent of the assignee.

On 15 December 2009, applicants filed the renewed petition under 37 CFR 1.137 and request under 37 CFR 1.497(d) considered herein. The submission includes written consent of the assignee and a statement under 37 CFR 3.73(b).

DISCUSSION

I. Request under 37 CFR 1.497(d)

A request under 37 CFR 1.497(d) to accept an oath or declaration changing inventorship must include:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

As indicated in the decision mailed 03 June 2009, items (1)-(2) have been complied with, and item (4) is not applicable.

With respect to item (3), applicants have provided written consent of the assignee.

II. Petition under 37 CFR 1.137(b)

Pursuant to 37 CFR 1.137(b), a petition to revive the present application based upon unintentional abandonment must include: (1) the proper reply, unless previously filed; (2) the petition fee under 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional; and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

As indicated in the 03 June 2009 decision, petitioners previously complied with items (2)-(4).

With respect to item (1), the declarations filed 05 October 2009 cannot be accepted at this time as there is a discrepancy between the name of an inventor as it appears on the declarations as compared to the international publication. Specifically, the first name of inventor Protic is identified in the international publication as "Voya", whereas the declarations identify the first name as "Voyislav". A petition under 37 CFR 1.182 is required to correct the name of an inventor where the error is more than the result of a merely typographical or transliteration error. See MPEP 1893.01(e).

CONCLUSION

For the above reasons, the request under 37 CFR 1.497(d) is **GRANTED**, and the petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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